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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,769	06/12/2000	Alain T. Rappaport	004239.P001	4769

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Thien T Nguyen
12400 Wilshire Boulevard 7th Floor
Los Angeles, CA 90025

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,769

Applicant(s)

RAPPAPORT, ALAIN T.

Examiner

Rachel L. Porter

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-22 and 24-60 is/are pending in the application.
- 4a) Of the above claim(s) 21, 22, 24-37 and 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-20, 38-49 and 57-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment received 2/17/03. Claims 1-7,10-22 and 24-60 are pending. Claims 21,22,24-37 and 50-56 have been withdrawn from further consideration as per the restriction requirement mailed 12/30/03.

Election/Restrictions

2. Applicant's election of Group I: claims 1-7,10-20, and 38-49 in amendment received 2/17/03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. This application contains claim 21,22,24-37 and 50-56 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the current rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 10-20, and 57-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely obtaining information about a patient regarding a diagnosis and performing various queries to does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention/method generates a set of queries and one or more documents for obtaining patient information, and is therefore considered useful, tangible, and concrete.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter. The deficiencies in the present claim language may be overcome by expressly stating in the

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body of the claims the use of technology, such as a *computer* processor and/or a *computer* database.

Claims 2-7, 10-20 and 57-59 inherit the deficiencies of claim 1 through dependency, and are also rejected.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1,5-7,10,10,20,38-39,41-46,48-49,58, and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Bessette (US Patent No.6,263,330).

[claim 1] Bessette teaches a method comprising:

- receiving information about a patient, the information about the patient including diagnosis information based upon a diagnosis (i.e. current medical condition of the patient) performed by a health care provider; (col. 4, lines 18-34, col. 7, lines 22-51; col. 14, line 40-col. 15, line 3)
- performing a query function to retrieve from a database a list of data sources based upon the received information about the patient; and (col. 7, line 52-col. 8, line 4; col. 15, lines 25-67)

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- generating at least one document containing the list of data sources retrieved from the database, (col. 13, lines 1-43) wherein performing the query function comprises:
 - o generating a set of queries containing query criteria based on the received information about the patient; and (Figures 2,4,6,8-9; col. 12, lines 1-67; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)
 - o executing the set of queries to retrieve from the database the list of data sources matching the query criteria, wherein generating the set of queries comprises selecting a set of existing queries that correspond to the received information about the patient. (Figures 2,4,6,8-9; col. 11, lines 11-56; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)

[claim 5] Bessette teaches a method wherein the information about the patient further comprises information selected from the group consisting of the patient's personal information, prescription information, laboratory information, procedures information, materials and supplies information and injection information. (Figures 6; col. 12, lines 18-43)

[claims 6-7] Bessette teaches a method wherein a data source is referenced by an address corresponding to a location where the data source resides and wherein the address corresponding to the location where the data source resides comprises a Uniform Resource Locator (URL). (col. 13, lines 23-38; col. 13, line 66-col. 14, line 21)

[claim 10] Bessette teaches a method wherein generating the set of queries comprises constructing a set of queries based on the information received. (col. 15, lines 25-67)

[claim 20] Bessette teaches a method wherein the query criteria include contextual information applicable to the diagnosis information received. (col. 7, line 52-col. 8, line 4; col. 11, lines 25-67; col. 15, lines 4-67)

[claim 38] Bessette teaches a system comprising:

- a first database to store multiple lists of content links, each list corresponding to a specific code; and (col. 8, line 52-col. 9, line 36; col. 13, lines 39-col. 14, line 21; col. 15, lines 4-24; col. 16, lines 5-29; Figures 3,5)
- a first server to receive information about a patient from at least one source, said information about the patient including at least one code, the first server to retrieve from the first database at least one list of content links based upon the at least one code received, (col. 8, line 52-col. 9, line 36; col. 13, lines 39-col. 14, line 21; col. 15, lines 4-24; col. 16, lines 5-29), the first server to generate at least one document containing the at least one list of content links retrieved from the first database, wherein the first server is to select a set of existing queries that correspond to information about the medical procedure to retrieve from the first database the at least one list of content links. (col. 15, line 52-col. 16, line 29; Figures 3,5)

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[claim 39] Bessette teaches a system wherein the at least one document generated is stored in a second database. (col. 13, lines 4-38; col. 15, lines 4-46)

[claim 41] Bessette teaches a system wherein the computer network is the Internet. (col. 6, line 64-col. 7, line 9)

[claim 42] Bessette teaches the system of claim 38, wherein the first server includes a machine-readable medium comprising instructions which, when executed by a machine, cause the machine to perform operations, the instructions to comprise:

- logic to receive the information about the patient from the at least one source; (col. 4, lines 18-34, col. 7, lines 22-51; col. 14, line 40-col. 15, line 3)
- logic to generate a set of queries based upon the at least one definition that corresponds to the at least one code received; and (col. 13, lines 23-col. 14, line 20; col. 15, lines 4-67)
- logic to execute the set of queries to retrieve from the first database the at least one list of content links that corresponds to the set of queries. (col. 13, lines 23-col. 14, line 20; col. 15, lines 4-67)

[claim 43] Bessette teaches a system wherein the at least one list of content links that is stored in the first database is identified using a set of queries generated the at least one definition that is associated with the respective at least one code. (col. 13, line 39-col. 14, lines 20; col. 15, lines 4-24, line 52-col. 16, line 29)

[claims 44-45] As per the limitations of claims 44-45, see Bessette: col. 11, line 40-56; col. 13, lines 23-col. 14, line 21; col. 15, line 4-col. 16, line 29.

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[claim 46] Bessette teaches a machine-readable medium comprising instructions which, when executed by a machine, cause the machine to perform operations comprising:

- receiving information about a patient, the information about the patient including diagnosis information based upon a diagnosis of the patient performed by a health care provider; (col. 4, lines 18-34, col. 7, lines 22-51; col. 14, line 40-col. 15, line 3)
- performing a query function to retrieve from a database a list of data sources based upon the received information about the patient; and (col. 7, line 52-col. 8, line 4; col. 15, lines 25-67)
- generating at least one document containing the list of data sources retrieved from the database (col. 13, lines 1-43, wherein performing the query function comprises:
 - o generating a set of queries containing query criteria based on the received information about the patient; and (Figures 2,4,6,8-9; col. 12, lines 1-67; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)
 - o executing the set of queries to retrieve from the database the list of data sources matching the query criteria, wherein generating the set of queries comprises selecting a set of existing queries that correspond to the received information about the patient. (Figures 2,4,6,8-9; col. 11, lines 11-56; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)

[claim 48] Bessette teaches a machine-readable medium wherein the diagnosis information comprises at least one description describing the patient's conditions or

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problems based upon the diagnosis performed by the health care provider. (col. 4, lines 18-34, col. 7, lines 22-51; col. 12, lines 18-42; col. 14, line 40-col. 15, line 3)

[claim 49] Bessette teaches the machine-readable medium of claim 48 wherein performing the query function comprises:

- generating a set of queries containing query criteria based on the received information about the patient; and (Figures 2,4,6,8-9; col. 12, lines 1-67; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)
- executing the set of queries to retrieve from the database the list of data sources matching the query criteria. (Figures 2,4,6,8-9; col. 11, lines 11-56; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)

[claim 58] Bessette teaches a method wherein contextual information includes at least one of a weight, an age and a sex. (col. 11, lines 25-39: e.g. age, group, sex)

[claim 60] System claim 60 repeats the subject matter of claim 1 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Bessette in the rejection of claim 1, it is readily apparent that the Bessette reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 1 and incorporated herein.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4, 11-16, 47, 57, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette (US Patent No. 6,263,330) in view of Evans (US Patent No. 5,924,074).

[claims 2-4] Bessette teaches a method that utilizes a plurality of medical codes (i.e. medical acts codes/treatment codes) to retrieve store and/or retrieve patient information relating to a patient's condition (col. 13, lines 52-65; col. 15, lines 4-24), but does not expressly disclose the use of diagnostic codes, such as ICD codes. Evans teaches a data retrieval system/method wherein receiving data in the patient's records comprises accessing procedure codes or diagnosis codes for procedures/diagnoses that the patient has undergone/received and wherein the codes are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11, lines 14-27). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of Bessette with the teachings of Evans to specifically include diagnostic codes (e.g. ICD codes) among the patient information. One would have been motivated to include this feature to facilitate a treating healthcare provider's access to a wide range of critical medical data relating to his/her patients. (See Bessette: col. 3, lines 27; col. 4, lines 18-

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53)

[claims 11-16]

Bessette teaches a method that utilizes a plurality of medical codes (i.e. medical acts codes/treatment codes) to retrieve store and/or retrieve patient information relating to a patient's condition (col. 13, lines 52-65; col. 15, lines 4-24), but does not expressly disclose the use of diagnostic codes, such as ICD codes. Evans teaches a data retrieval system/method wherein receiving data in the patient's records comprises accessing procedure codes or diagnosis codes for procedures/diagnoses that the patient has undergone/received and wherein the codes are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11, lines 14-27). Evans further discloses that descriptions of diagnosis (i.e. diagnosis identifier) may be determined/derived from information received. (Figures 18,20; col. 11, lines 10-30) At the time of the Applicant's invention, it would have been obvious to one of ordinary in the art to combine the teachings of Bessette with the teachings of Evans to specifically include diagnostic codes/identifiers (e.g. ICD codes) among the patient information received. One would have been motivated to include this feature to facilitate a treating healthcare provider's access to a wide range of critical medical data relating to his/her patients. (See Bessette: col. 3, lines 27; col. 4, lines 18-53)

[claim 47] The limitations of claim 47 are addressed by the rejection of claims 11-16 and 46, and incorporated herein.

[claim 57] Bessette teaches a system wherein the diagnosis description describes an

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agent that is causally related to the diagnosis information. (col. 7, lines 52-col. 8, line 4; col. 12, lines 18-42—e.g. allergies, tissue antigens, genetic deficiencies)

[claim 59] Bessette describes a method wherein the user may submit a query to generate documents containing medical information and further refine the query based upon the medical information/documents received. (col. 15, lines 25-33; line 52-col. 16, line 29). Bessette does not expressly disclose that the documents retrieved include parent and child diagnostic codes, but does teach a method for retrieving documents containing medical/treatment code information (i.e. list of diagnostic codes) used to categorize patients (col. 13, lines 23-65; col. 15, lines 4-24—i.e. a hierarchy of medical/treatment codes). Evans discloses a method that retrieves documents that contain a hierarchical list of diagnostic codes (i.e. parent/child diagnostic codes) and wherein the parent (i.e. generic) or child (i.e. specific) codes may be selected. (Figure 20—e.g. Asthma (493); Asmtha unspecified (493.9). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Bessette with the teaching of Evans to provide a listing of hierarchical diagnostic codes (i.e. parent/child diagnostic codes). One would have been motivated to include this feature to ensure that the patient record provides the most accurate and detailed information regarding the patient's medical condition(s) (e.g. to avoid possible misdiagnoses in the future). (See Bessette: col. 6, lines 44-46)

9. Claims 17-19 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette in view of Rozen et al (USPN 6,073,106)

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[claims 17-18] Bessette teaches a system and method for allowing users (e.g. healthcare providers) to query one or more databases and to retrieve documents regarding patient information, but does not expressly disclose that the patient may access the system to access his/her own medical records and to provide feedback on his/her medical records. Rozen et al teach a system wherein the patient may access his/her data via a network that includes a WAN or the Internet (col. 4, lines 33-col. 5, line 9; col. 5, lines 21-41; col. 7, lines 4-39). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Bessette with the teaching of Rozen to allow patients to access their medical data via a network and to provide feedback regarding those medical files. One would have been motivated to do this to enable the patient to provide up-to-date data regarding medical conditions, to ensure that the medical history is as accurate as possible for treating healthcare providers. (See Rozen, col. 1, lines 16-45; col. 2, line 4-38; col. 4, line 66- col. 5, line 11)

[claim 19] Bessette discloses a method wherein the computer network is selected from the group consisting of a local area network, a wide area network, and the Internet. (col. 6, line 64-col. 7, lines 21)

[claim 40] The limitations of claim 40 are addressed by the rejection of claims 17-18 and 38, and incorporated herein.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Kirk et al (USPN 5,768,578) teaches a method for retrieving information by providing a listing of the data sources, including URL's.
- Evans et al (USPN 6,266,675) teach a system for querying of relational databases for patient data.
- Fujisawa (JP 06290277 A) teaches a system/method for storing, retrieving and providing a listing of medical record data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

RP
RP
May 3, 2004

Michael C. Porter
EXAMINER
PRIMARY EXAMINER
Art 3626